

Application No.: 09/817,123

Docket No.: 21987-00054-US

REMARKS

Claims 1, 6-15, and 39-40 are now pending in this Application. Claims 1 and 6 are independent. Dependent claims 39-40 have been added, and no claims have been amended or canceled by this amendment.

Unpatentability Rejections over Gilboa, Zalewski, and Hikawa et al.

Withdrawal of the rejections of claims 1, 6, 7, 10, 11, and 15 under 35 U.S.C. §103(a) as being unpatentable over Gilboa (US 5,853,327) in view of Zalewski (US 5,991,693) and Hikawa et al. (US 5,526,306) is requested. The Examiner has failed to make a *prima facie* case of obviousness.

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference must teach or suggest all the claim limitations*.¹ Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.²

At least with respect to independent claims 1 and 6, the applied art fails to teach or suggest all the claimed limitations. Further, the Examiner's assertion of "implicit" or "inherent" features in the applied art is deficient, as discussed below.

For example, the applied art, taken alone or in combination, does not teach or suggest a game apparatus which includes, among other features, "means for notifying the first control device that the received driving electric power has reached a predetermined quantity of electric power...", as recited in independent claim 1.

Further, the applied art, taken alone or in combination, does not teach or suggest a information communication system which includes, among other features, "...means for providing a notification that the received driving electric power has reached a predetermined quantity of electric power...", as recited in independent claim 6.

¹ See MPEP §2143.

² *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and *See* MPEP §2143.

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Applicant respectfully traverses the assertion that the recited limitation in claims 1 and 6 of "means for notifying the first control device that the received driving electric power has reached a predetermined quantity of electric power" is "implicitly" provided by the teachings of Gilboa.

Applicant submits that this is an overreaching interpretation of the applied art to assert that the above-cited limitation is "implicit to the functionality of a coil resonance system such as the one taught by Gilboa."³

It appears that the Examiner is attempting to improperly assert that the device of Gilboa has an inherent function which negates the novelty and non-obviousness of applicant's claimed invention.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"⁴

As the Federal Circuit held in *Newell*, a retrospective view of inherency is not a substitute for some teaching or suggestion that supports the selection and use of the elements in the particular claimed combination. In deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art; for that which may be inherent in not necessarily known, and obviousness cannot be predicated on what is unknown.⁵

Further, as held by the USPTO Board of Patent Appeals and Interferences in *Skinner*, the Examiner must provide some evidence or scientific reasoning to establish the reasonableness of the Examiner's belief that the functional limitation is an inherent characteristic of the prior art before the applicant can be put through the burdensome task of proving that the subject matter in the prior art does not possess the characteristics relied upon by the Examiner.⁶

Therefore, since the applied art does not teach or suggest all the limitations claimed in independent claims 1 and 6, and since the Examiner's assertion of inherent or implicit features in the applied art does not meet the requirements of the MPEP, the Examiner has failed to make his

³ See Official Action at p. 6, "Response to Arguments".

⁴ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

⁵ *In re Newell*, 891 F.2d 899 (Fed. Cir. 1989).

⁶ *Ex parte Skinner*, 2 U.S.P.Q.2d 1788 (B.P.A.I. 1986); and see MPEP §2142.

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required *prima facie* case of obviousness. Accordingly, reconsideration and allowance of independent claims 1 and 6 are requested.

Further, since dependent claims 7-15 variously and ultimately depend from allowable claim 6, reconsideration and allowance of these dependent claims is also requested, without recourse to the additional patentable features recited therein.

Unpatentability Rejections over Gilboa, Zalewski, Hikawa et al. and Bergeron

Withdrawal of the rejections of claims 8, 9, and 12-14 under 35 U.S.C. §103(a) as being unpatentable over Gilboa (US 5,853,327) in view of Zalewski (US 5,991,693), Hikawa et al. (US 5,526,306), and Bergeron (US 4,764,666) is requested.

The legal standard for unpatentability has been set forth above.

Bergeron fails to Make up for the Deficiencies of Gilboa, Zalewski, and Hikawa et al

Bergeron is offered as teaching a contact terminal for transmitting and receiving information from/to programmable game entry cards used in an on-line wagering system.

Whether or not Bergeron teaches or suggest that for which it is offered by the Examiner, Bergeron does not make up for the previously identified deficiencies of Gilboa, Zalewski, and Hikawa et al., at least with respect to independent claim 6, from which dependent claims 8-14 variously and ultimately depend.

Therefore, since the applied art, taken alone or in combination, does not teach or suggest all the claimed limitations, withdrawal of the rejection and allowance of claims 8-14 are requested.

New Dependent Claims 39-40

Newly added dependent claims 39-40 have been drafted to avoid the applied art and to define further aspects of Applicant's invention. None of the applied art teaches or suggests that the first control device interrupts a radio wave transmission for a predetermined period of time after receiving a notification that the received driving electric power has reached the predetermined quantity of electric power.

Therefore, consideration and allowance of claims 39-40 are respectfully requested.

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Conclusion

In view of the above, each of the presently pending claims 1, 6-15, and 39-40 in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

In the event the Examiner believes that an interview would be helpful in resolving any outstanding issues in this case, the undersigned attorney is available at the telephone number indicated below.

For any fee that is due, including fees for extensions of time, please charge CBLH Deposit Account No. 22-0185, under Order No. 21987-00054-US from which the undersigned is authorized to draw.

Respectfully submitted,

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